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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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| Proceeding             | 88190652   |
| Applicant              | BFY LLC  |
| Applied for Mark       | SLEEPEEZ   |
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Serial No. 88/190,652

Applicant: BFY, LLC

Mark:

**SLEEPEEZ**

Examining Atty: Michael FitzSimons  
Stacy Wahlberg  
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**APPLICANT'S *EX PARTE* REPLY BRIEF**

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Applicant, BFY, LLC, hereby submits this Reply Brief in response to the Examining Attorney's brief filed on July 29, 2021. Applicant has appealed the Examining Attorney's refusal to register Applicant's standard character SLEEPEEZ mark in Application Serial No. 88/190,652 ("Applicant's mark") on the grounds that Applicant's Mark, for use in connection with "[h]omeopathic pharmaceuticals for use in the treatment of children's sleeping problems" and "[m]edicated candies for use in the treatment of children's sleeping problems" in International Class 5, is confusingly similar to the mark SLEEPEASE (Reg. No. 4,123,390) pursuant to Trademark Act Section 2(d), 15 U.S.C. § 1052(d). In its brief, the Examining Attorney attacked the validity of the evidence presented by Applicant, rejecting the conclusion that the registered mark is conceptually and commercially weak, and therefore the differences between it and Applicant's mark are enough to avoid confusion.

### **ARGUMENT**

Applicant's SLEEPEEZ mark is in fact not likely to cause confusion with the registered SLEEPEASE mark because Applicant has in fact demonstrated that the mark is conceptually and commercially weak. Based on dictionary evidence *and* third-party registrations, it is clear that the registered mark is conceptually weak for oral spray meant to alleviate insomnia. Further, the third-party use evidence is indeed sufficient to show Registrant's mark is entitled to a narrow scope of protections, as the marks introduced are visually and phonetically similar and are used on the same or related goods.

#### **I. SLEEPEASE is Conceptually Weak**

The Examining Attorney spends a significant amount of the response brief addressing

Applicant's evidence of third-party registrations, noting that while Applicant asserts the uses are probative for showing weakness of the two terms—"SLEEP" and "EASE"—in Registrant's mark, "the third-party registration evidence is insufficient in quantity and in similarity to show that "SLEEPEASE" is conceptually weak." *See* Examiners Br. at. 11.

Applicant disagrees with this assertion, and also emphasizes that the third-party registrations serve to supplement Applicant's submitted dictionary evidence of the definition of the term "EASE."<sup>1</sup> *See* Applicant's Request for Reconsideration, Exhibit AG. "EASE" means "free from pain or discomfort." *See id.* The combination of SLEEPEASE, then, implies the homeopathic oral spray product sold under the SLEEPEASE mark helps make going to sleep or staying asleep less difficult. This meaning is highly suggestive of a characteristic of Registrant's goods, and therefore Registrant's mark is entitled to a narrower scope of protection, such that Applicant's mark can coexist on the trademark register.

## **II. SLEEPEASE is Commercially Weak**

The Examining Attorney also attempts to discredit Applicant's submitted third-party use evidence in numerous ways, and Applicant will address these in turn. Contrary to the Examining Attorney's arguments, *all* of the marks are able to be interpreted as the phonetic equivalent of SLEEPEASE, the goods sold under all of the marks are related, and there is no requirement that an Applicant establish the reach of an internet business through customer reviews or sales receipts.

First, the Examining Attorney suggests that six of Applicant's 26 presented marks, specifically, the ones spelled "SLEEP EZ," "SLEEPEZ," "SLEEP EZE," and "SLEEP-EZE," are not examples of marks that combine "SLEEP" and "EASE." Applicant strongly disagrees. To

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<sup>1</sup> A definition for "SLEEP" was not provided by either party, as it is a commonly understood term in the context of the marks at issue.

begin with, these marks are only one letter or one rearranged letter different from Applicant's SLEEPEEZ mark, which the Examining Attorney asserts is phonetically equivalent to SLEEPEASE. *See* Examiner's Br. at 3. Further, as demonstrated in the Examining Attorney's evidence from the American Heritage Dictionary as well as Merriam-Webster, the phonetic spelling of "EASE" is actually "ēz," the same suffix featured in the "SLEEP EZ" and "SLEEPEZ" marks. *See* Office Action of Dec. 10, 2018, pp. 11-24. The suffix "EZE" is also likely to be pronounced as "EASE," given that the first "E" is in a position in front of "ZE," which indicates phonetically that the vowel before the "z" will have a long sound. The Examining Attorney has not introduced any evidence of alternative pronunciations, so there is a high likelihood that consumers would both pronounce and view these marks as the equivalent of "EASE," making these marks firmly part of the crowded field of "SLEEP" "EASE" marks.

The Examining Attorney also suggests that some of the goods sold under the submitted third party uses are not related to the homeopathic oral sprays identified by Registrant in Class 5. *See* Examiners Br. at 14. Specifically, that nine of the marks are used for unrelated goods such as massage candles, bath salts, herbal teas, inhalation beads, and "other topical goods."<sup>2</sup> *See id.* In fact, bath salts for medical medicinal use and herbal teas for medicinal purposes are classified in Class 5, making them related to Applicant's homeopathic oral sprays also in Class 5. Applicant also notes that "[i]t is sufficient that the goods and/or services of the applicant and the registrant are related in some manner or that the conditions surrounding their marketing are such that they are likely to be encountered by the same persons under circumstances that, because of the marks used in connection therewith, would lead to the mistaken belief that they originate from the same source." *See* TMEP § 1207.01(a)(i), citing *On-line Careline Inc. v. America Online Inc.*, 56 USPQ2d 1471 (Fed. Cir. 2000) (holding ON-LINE TODAY for Internet connection services and

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<sup>2</sup> It is unclear what this refers to as none of the evidence supplied by Applicant is a purely topical product.

ONLINE TODAY for an electronic publication likely to cause confusion); *In re Martin's Famous Pastry Shoppe, Inc.*, 223 USPQ 1289 (Fed. Cir. 1984) (holding MARTIN'S for wheat bran and honey bread, and MARTIN'S for cheese, likely to cause confusion); *Weider Publ'ns, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347 (TTAB 2014) (holding SHAPES for a variety of beauty salon, day spa, and health spa services likely to cause confusion with SHAPE for magazines where the services are of the type normally featured in the magazines); *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1433 (TTAB 2013) (holding GOTT LIGHT for various water beverages likely to cause confusion with GOTT and JOEL GOTT for wine); *Gen. Mills, Inc. v. Fage Dairy Processing Indus. S.A.*, 100 USPQ2d 1584, 1597 (TTAB 2011) (holding composite marks containing the word TOTAL for yogurt and other products likely to cause confusion with the mark TOTAL for ready-to-eat breakfast cereal).

Here, all of the third-party products put into the record by Applicant are ingestible or inhalable ways to “EASE” someone’s “SLEEP.” They are likely to be bought by similar consumers, looking for a medication or homeopathic remedy to allow them to fall asleep or stay asleep. This is in fact a strong indication that the goods are “similar in kind;” they are made and used for the same purposes by the same classes of consumers.

Finally, the Examining Attorney provides a string cite of cases to support the contention that Applicant has not established the reach of the third-party use, therefore, the use is not probative. *See* Examiners Br. at 14. This analysis is incorrect. All the cases cited were decided before the precedential decision in *Jack Wolfskin Ausrüstung Fur Draussen GmbH v. New Millennium Sports, S.L.U.*, where the Federal Circuit held that, “***extensive evidence of third party use and registration is ‘powerful on its face’ even where the specific extent and impact of the usage has not been established.***” 116 USPQ2d 1129, 1136 (Fed. Cir. 2015). As that case



clearly states, it is not necessary for Applicant to establish the reach of the third-party use presented through customer reviews, sales, or the like. Indeed, such a requirement would put an unnecessarily heavy burden on the applicant.

Because the third party uses presented by Applicant are for the same or similar marks and goods, they are relevant to support the commercial weakness of the cited mark. This commercial weakness shows that consumers have learned to differentiate between the marks in the marketplace based on small differences, such as the spellings of SLEEPEASE and SLEEPEEZ. It is therefore highly unlikely that any consumer would be confused as to the source of Applicant's goods.

### **CONCLUSION**

For the foregoing reasons, Applicant respectfully asserts that Applicant's SLEEPEEZ mark is not confusingly similar to the registered SLEEPEASE mark.

WHEREFORE, Applicant respectfully requests that the Board REVERSE the statutory refusal pursuant to Trademark Act Section 2(d)(1) and allow the Application to proceed to publication and registration on the Principal Register.

Dated this 16th day of August, 2021.

Respectfully submitted,



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Erik M. Pelton